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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,746	02/29/2000	Dennis Albert Doidge	RAL97-0043US2	1341

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EXAMINER

HO, DUC CHI

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 08/09/2004

11/4/2

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/515,746

**Applicant(s)**

DOIDGE ET AL.

**Examiner**

Duc C Ho

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22,24,25 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22,24,25 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>11</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 22, 24-25, and 34-37 are rejected under 35 U.S.C. 112, first paragraph because the specification, while being enabling for a “format conversion” known to the inventor, does not reasonably provide an enablement for the “format converter” recited in claim 22 and “bridging apparatus” as in claim 24. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the “format converter” and “bridging apparatus” the invention commensurate with these claims.

As recited in claim 22, the single means “comprised only of hardware for bridging frames from a first frame to a second frame format” does not appear in combination with another recited element of means, is subjected to an undue breadth rejection under 35 U.S.C. 112, first paragraph (2164.08(a)). In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). The same remark applies to the single means “comprised only of hardware for converting and forwarding frames having a first frame to frames having a second frame format” as recited in claim 24.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22, 24-25, and 34-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 22, it is unclear as to how a format converter performs conversion from one format to another format without processor intervention. The same remark applies to claim 24.

Regarding claim 34, it appears to Examiner that the format conversion must occur at the ATM port 60-fig. 3, where a LAN/switch format is converted to an ATM format. It is unclear as to what is intended to be the claim limitation by reciting "the first frame format is a format selected from the group of ATM format and LAN format and the second frame format is a switch format". The same remark applies to claims 35-37.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent,

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 22, 24-25, and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Burwell et al. (US 5,818,842), hereinafter referred as Burwell.

Regarding claim 22, Burwell discloses transparent interconnector of LANs by an ATM network.

*a format converter ( a ridge 6-fig. 3) comprised only of hardware for bridging frames from a first frame format to a second frame format, said bridging without requiring processor intervention (the ridges 6-fig. 3 performs bridging from inputs of a 12 Ethernet ports to a single ATM port at the output , see*

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column 7-line 28 to column 9-41. IP frames enters at Ethernet port 20 and being converted to ATM frames through the process of adding VPI/VCI to the IP frames by the ridge, see column 8, lines 47-67).

Regarding claims 34-35, the Ridge 6-fig. 3 comprises a plurality of Ethernet LAN ports 20 and an ATM port 22. Therefore, the Ridge can process either Ethernet LAN frame or ATM format (first format) at their respective port, and vice versa, to an encapsulated format appropriate for the Ridge (the switch format) to be sent through the Ridge.

Regarding claim 24, the claim has similar limitations as claim 22. Therefore, it is rejected under Burwell for the same reasons set forth in the rejection of claim 22.

Regarding claim 25, the Ridge's destination address table functions as a conversion table for assisting the conversion and forwarding of frames.

Regarding claims 36-37, these claims have similar limitations as claims 34-35, respectively. Therefore, they are rejected under Burwell for the same reasons set forth in the rejection of claims 34-35.

### ***Response to Arguments***

6. Applicant's arguments filed 5-28-04 have been fully considered but they are not persuasive. Examiner's opinion is that the ridge 6-fig. 3 of Burwell comprising only hardware. The function of outgoing frame processor 25, and incoming frame processor 26-fig 4 in the ridge 6 is for controlling the input and output of the frame traffic, not for conversion.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (703) 305-1332. The examiner can normally be reached on Monday through Friday from 7:00 am to 3:30 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone 22, 24-25, and 34-37 number is (703) 305-4750

9. Any response to this final action should be mailed to:

**Box AF**

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Or faxed to:**

(703) 872-9315,

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive,

Arlington, VA, Sixth Floor (Receptionist).

Patent Examiner

A handwritten signature in cursive script, appearing to read "Duc Ho", written over the printed name.

Duc Ho

8-6-04